



05/20/04

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(MBHB Case No. 97,022-D1-CO)

Application of:

Rubin, et al.

Serial No. 10/685,737

Filed: October 15, 2003

Title: A System for Cell-Based Screening

Examiner: To be assigned

Art Unit: 1641

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

1. We are transmitting herewith the attached papers for the above-identified patent application:

- ☒ Transmittal Letter (1 Sheet);
- ☒ IDS and 1449 Form in compliance with the continuing duty of candor in 37 CFR § 1.56 (13 Sheets);
- ☒ Supplemental Information Disclosure Statement and 1449 Form (5 sheets);
- ☒ 6 cited references
- ☒ Return Receipt Postcard

2. With respect to fees:

- ☒ No fee required.

3. **GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES:** Please charge any additional fees or credit overpayment to Deposit Account No. **13-2490**. A duplicate copy of this sheet is enclosed.

4. **CERTIFICATE OF MAILING BY "EXPRESS MAIL" UNDER 37 CFR § 1.10:** The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein-above, are being deposited with the United States Postal Service with sufficient postage as "Express Mail Post Office to Addressee" in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on this 19th day of **May, 2004**. Express Mail No. **EV334706095US**.

By: _____

David S. Harper

Reg. No. **42,636**



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 97,022-D1-CO)

In application of:)	
)	
Rubin, et al.)	
)	Group Art Unit: 1641
Serial No. 10/685,737)	
)	Examiner: To be assigned
Filed: October 15, 2003)	
)	
For: A System for Cell-Based Screening)	

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. Section 1.97 - 1.99, the Applicant wishes to make the following references of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56. Pursuant to 37 C.F.R. §1.98(d), copies of references numbered 1-70 are not provided herewith, since they were previously filed in the parent application.

Applicants do not believe any fee is due with this submission. If this belief be in error and the Patent Office determines that the fee prescribed in the relevant portion of 37 C.F.R. Section 1.97 is applicable, the undersigned attorney by his signature hereby authorizes any such fee to be debited from Deposit Account 13-2490.

This Information Disclosure Statement is being filed:

- ☒ within three months of the filing date of a national application; within three months of the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or before the mailing date of a first Office Action on the merits. 37 C.F.R. § 1.97 (b)
- ☐ **after** three months of the filing date of a national application, or the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or **after** the mailing date of a first Office Action on the merits, but **before** the mailing date of a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), and includes (37 C.F.R. § 1.97 (c):
- ☐ the Certification under 37 C.F.R. § 1.97(e) (see “Certification” below)

OR

- ☐ the fee of \$240 set forth in 37 C.F.R. § 1.17(p) (see “Fees” below).
- ☐ **after** a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), but before, or simultaneously with, the payment of the issue fee, and includes the Certification under 37 C.F.R. § 1.97(e) (see “Certification” below), and the Petition Fee set forth in 37 C.F.R. § 1.17(i) (see “Fees” and “Method of Payment of Fees” below). Applicants hereby petitions for consideration of the Information Disclosure Statement submitted herewith and the accompanying references in examination of the subject patent application.

CERTIFICATION

- ☐ The **undersigned** hereby certifies that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application not more than three months prior to the filing of the Information Disclosure Statement.
- ☐ The **undersigned** hereby certifies that no item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.

FEES

- ☒ **No fee** is owed by the applicant(s).
☐ The **IDS Fee of \$240.00** under 37 C.F.R. § 1.17(p) is enclosed herewith.
☐ The **Petition Fee of \$130.00** set forth in 37 C.F.R. § 1.17(i) is enclosed herewith.

METHOD OF PAYMENT OF FEES

- ☐ Attached is a check in the amount of \$_____.
☐ Charge Deposit Account No. 13-2490 in the amount of \$_____. (A duplicate copy of this communication is enclosed for that purpose.)

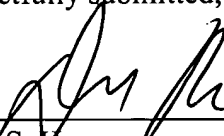
Please charge any underpayment or credit any overpayment in connection with this communication to Deposit Account No. 13-2490. A duplicate copy of this communication is enclosed for this purpose.

CERTIFICATE OF MAILING VIA EXPRESS MAIL DELIVERY under 37 C.F.R. § 1.10. I hereby certify that the attached paper of fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on this 19th day of May, 2004. **Express Mail No. EV334706095US.**

Date: _____

5/19/04

Respectfully submitted,



David S. Harper

Registration No. 42,636

Telephone: 312-913-0001
Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff
300 South Wacker Drive
Chicago, IL 60606



U.S. Patent Documents:

1. U.S. Patent No. 5,670,113, Issued on September 23, 1997.
2. U.S. Patent No. 5,732,150, Issued on March 24, 1998.
3. U.S. Patent No. 5,790,710, Issued on August 4, 1998.
4. U.S. Patent No. 5,885,840, Issued on March 23, 1999.
5. U.S. Patent No. 5,072,382, Issued on December 10, 1991.
6. U.S. Patent No. 5,107,422, Issued on April 21, 1992.
7. U.S. Patent No. 4,647,531, Issued on March 3, 1987.
8. U.S. Patent No. 5,919,646, Issued on July 6, 1999.
9. U.S. Patent No. 5,891,646, Issued on April 6, 1999.
10. U.S. Patent No. 6,004,808, Issued on December 21, 1999.

Foreign Documents:

11. Aurora Biosciences Corporation, International Published Application No. WO 98/13353, Published April 2, 1998.
12. Aurora Biosciences Corporation, International Published Application No. WO 97/48820, Published December 24, 1997.
13. Htun, Han, et al., International Published Application No. WO 97/20931, Published on June 12, 1997.
14. Brass, Lawrence, et al., International Published Application No. WO 98/10287, Published on March 12, 1998.
15. Dunlay, R. Terry, et al., International Published Application No. WO 98/38490, Published on September 3, 1998.
16. Keith Olson, et al. International Published Application No. WO 00/70342, Published on November 23, 2000.
17. Kenneth Giuliano, et al., International Published Application No. WO 00/50872, Published on August 31, 2000.
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19. Kenneth Giuliano, et al. International Published Application No. WO 00/03246, Published on January 20, 2000.

20. Keith Olson, et al., PCT International Published Application No. WO 00/26408, Published on May 11, 2000.
21. Soeren Tullin, et al., PCT International Published Application No. WO 98/45704, Published October 15, 1998.
22. Kenneth Giuliano, et al., PCT International Published Application No. WO 97/45730, Published on December 4, 1997.

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59. Giuliano, Kenneth A., et al., (1998), *Trends in Biotechnology*, GB, Elsevier Publication, Cambridge, "Fluorescent-protein biosensors: new tools for drug discovery", 16:(3) pp. 135-140.
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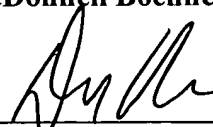
Co-pending applications

The Applicants hereby notify the Examiner of the following commonly owned co-pending applications:

10/430,534 (Filed May 6, 2003)
09/718,770 (Filed November 22, 2000)
09/721,168 (Filed November 22, 2000)
10/411,635 (Filed April 11, 2003)
09/723,256 (Filed November 27, 2000)
10/686,161 (Filed October 15, 2003)
09/598,347 (Filed June 21, 2000)

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

Date: 5/19/04

By: 

David S. Harper
Reg. No. 42,636



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 97,022-D1-CO)

In application of:)	
)	
Rubin, et al.)	
)	Group Art Unit: 1641
Serial No. 10/685,737)	
)	Examiner: To be assigned
Filed: October 15, 2003)	
)	
For: A System for Cell-Based Screening)	

SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. Section 1.97 - 1.99, the Applicant wishes to make the following references of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56. Copies of the references cited below are enclosed. These references are also listed on the enclosed PTO Form 1449.

In the judgment of the undersigned, portions of the listed references may be material to the Examiner's consideration of the presently pending claims. However, the references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is intended as to the relative relevance between references, whether cited in this or prior statements. This statement is not a representation that the listed references have effective dates early enough to be "prior art" within the meaning of 35 U.S.C. Section 102 or Section 103.

This Information Disclosure Statement is being filed:

- ☒ within three months of the filing date of a national application; within three months of the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or before the mailing date of a first Office Action on the merits. 37 C.F.R. §1.97 (b)
- ☐ **after** three months of the filing date of a national application, or the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or **after** the mailing date of a first Office Action on the merits, but **before** the mailing date of a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), and includes (37 C.F.R. § 1.97 (c):
- ☐ the Certification under 37 C.F.R. § 1.97(e) (see "Certification" below)

OR

- ☐ the fee of \$180.00 set forth in 37 C.F.R. § 1.17(p) (see "Fees" below).
- ☐ **after** a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), but before, or simultaneously with, the payment of the issue fee, and includes the Certification under 37 C.F.R. § 1.97(e) (see "Certification" below), and the Petition Fee set forth in 37 C.F.R. § 1.17(i) (see "Fees" and "Method of Payment of Fees" below). Applicants hereby petitions for consideration of the Information Disclosure Statement submitted herewith and the accompanying references in examination of the subject patent application.

CERTIFICATION

- ☐ The **undersigned** hereby certifies that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application not more than three months prior to the filing of the Information Disclosure Statement.
- ☐ The **undersigned** hereby certifies that no item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.

FEES

☒
☐

No fee is owed by the applicant(s).

The IDS Fee of \$ _____ under 37 C.F.R. § 1.17(p) is enclosed herewith.

METHOD OF PAYMENT OF FEES

☐
☐

Attached is a check in the amount of \$ _____.

Charge Deposit Account No. 13-2490 in the amount of \$ _____. (A duplicate copy of this communication is enclosed for that purpose.)

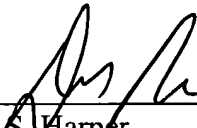
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Respectfully submitted,

Date: _____

5/19/04



David S. Harper

Registration No. 42,636

Telephone: 312-913-0001

Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff

300 South Wacker Drive

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300 S. Wacker Drive, Suite 3200
Chicago, IL 60606
312-913-0001



U.S. Patent References:

1. R. Terry Dunlay, et al., U.S. Patent No. 6,727,071, Issued on April 27, 2004.
2. R. Terry Dunlay, et al., U.S. Patent No. 6,620,591, Issued on September 16, 2003.
3. Kenneth Giuliano, et al., U.S. Patent No. 6,416,959, Issued on July 9, 2002.
4. R. Terry Dunlay, et al., U.S. Patent No. 5,989,835, Issued on November 23, 1999.
5. R. Terry Dunlay, et al., U.S. Patent No. 6,573,039, Issued on June 3, 2003.
6. R. Terry Dunlay, et al., U.S. Patent No. 6,671,624, Issued on December 30, 2003.

Date: _____

5/19/04

Respectfully Submitted,

By: _____

David Harper

Reg. No. 42,636

McDonnell, Boehnen

Hulbert & Berghoff

300 South Wacker Drive

Chicago, IL 60606

Form PTO-1449

U.S. Department of Commerce
Patent and Trademark Office

Atty. Docket No.

Serial No.

97,022-D1-CO

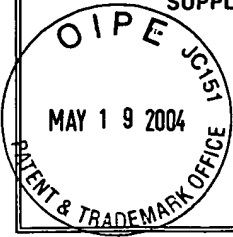
10/685,737

SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Applicant: Rubin, et al.

Filing Date: October 15, 2003

Group: 1641



U. S. PATENT DOCUMENTS

Examiner Initials		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
	1	6,727,071	4-27-04	Dunlay, et al.	33/53	435/7.21	2-27-98
	2	6,620,591	7-16-03	Dunlay, et al.	33/533	435/7.2	4-16-99
	3	6,416,959	7-9-02	Giuliano, et al.	33/533	435/7.2	2-25-00
	4	5,989,835	11-23-99	Dunlay, et al.	33/533	435/7.2	2-27-97
	5	6,573,039	6-3-03	Dunlay, et al.	33/53	435/4	8-29-00
	6	6,671,624	12-30-03	Dunlay, et al.	33/48	702/19	11-27-00

FOREIGN PATENT DOCUMENTS

		Document Number	Date	Country	Class	Subclass	Translation Yes No
Examiner				Date Considered			

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with any communication.

Form PTO-1449

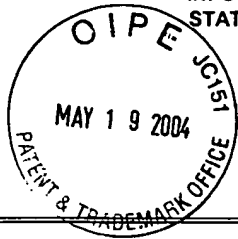
U.S. Department of Commerce
Patent and Trademark Office

Atty. Docket No.

97,022-D1-CO

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INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Applicant: Rubin, et al.

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U. S. PATENT DOCUMENTS

Examiner Initials		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
	1	5,670,113	9-23-97	Akong, et al.			12-13-92
	2	5,732,150	3-24-98	Zhou, et al.			9-19-95
	3	5,790,710	8-4-98	Price, et al.			1-17-97
	4	5,885,840	3-23-99	Kamentsky, et al.			2-10-97
	5	5,072,382	12-10-91	Kamentsky, et al.			10-2-89
	6	5,107,422	4-21-92	Kamentsky, et al.			9-14-90
	7	4,647,531	3-3-87	Kamentsky, et al.			2-6-84
	8	5,919,646	7-6-99	Okun, et al.			8-1-97
	9	5,891,646	4-6-99	Barak, et al.			6-5-97
	10	6,004,808	12-21-99	Negulescu, et al.			6-19-97

FOREIGN PATENT DOCUMENTS

		Document Number	Date	Country	Class	Subclass	Translation Yes No	
	11	WO 98/13353	4/2/98	PCT			X	
	12	WO 97/48820	12/24/97	PCT			X	
	13	WO 97/20931	6/12/97	PCT			X	
	14	WO 98/10287	3/12/98	PCT			X	
	15	WO 98/38490	9/3/98	PCT			X	
	16	WO 00/70342	11/23/00	PCT			X	
	17	WO 00/50872	8/31/00	PCT			X	
	18	WO 00/17643	3/30/00	PCT			X	
	19	WO 0/03246	1/20/00	PCT			X	
	20	WO 00/26408	5/11/00	PCT			X	
	21	WO 98/45704	10/15/98	PCT			X	
	22	WO 97/45730	12/4/97	PCT			X	

Examiner

Date Considered

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with any communication.

Form PTO-1449 U.S. Department of Commerce Patent and Trademark Office INFORMATION DISCLOSURE STATEMENT BY APPLICANT	Atty. Docket No. 97,022-D1-CO	Serial No. 10/685,737
	Applicant: Rubin, et al.	
	Filing Date: October 15, 2003	Group: 1641

OTHER DOCUMENTS - Including Author, Title, Date, Pertinent Pages, Etc.

23	Cosima T. Baldari, et al., (1998), <i>Biologicals</i> , 26(1): pp. 1-5.
24	David Baldwin Jr., et al., (1980), <i>Proc. Natl. Acad. Sci.</i> , 77(10): pp. 5975-5978.
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